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In re Application of :
Daly et al. :
Serial No.: 09/509,196 : PETITION DECISION
Filed: March 23, 2000 :
Attorney Docket No.: 1871-129 :

This is in response to the petition under 37 CFR 1.181, filed November 09, 2006, requesting that the examiner issue a second Examiner's Answer containing a New Ground of Rejection. The delay in acting upon this petition is regretted.

BACKGROUND

A review of the file history shows that the examiner mailed a final Office action to applicants on February 01, 2006 wherein claims 5-7, 19-22, 24-29 and 31-41 were rejected under 35 U.S.C. 101 because the claimed invention is drawn to an invention with no apparent or disclosed specific and substantial credible utility essentially for reasons of record in the previous Office actions. Claims 5-7, 19-22, 24-29 and 31-41 were also rejected under 35 U.S.C. 112, first paragraph, because the claimed invention is not supported by either a clear asserted utility or a well established utility and, therefore, one skilled in the art would not know how to use the claimed invention.

In response, applicants filed an Appeal Brief on June 06, 2006 arguing that the rejections made in the previous final Office action were flawed.

On September 18, 2006, the examiner mailed an Examiner's Answer setting forth the same rejections set forth in the final Office action of February 01, 2006 and addressed the arguments set forth in the Appeal Brief.

In response thereto, appellants filed this petition under 37 CFR 1.181, on November 09, 2006, requesting that the examiner issue a second Examiner's Answer containing a New Ground of Rejection. Appellants filed a reply brief concurrently with this petition.

DISCUSSION

Appellants submit that the statement and grounds of rejection for the rejection of claims 5-7, 19-22, 24-29 and 31-41 under 35 U.S.C. 101 were changed in the Examiner's Answer from those used in the final rejection. Specifically, the examiner stated in the grounds for the rejection that the "claimed invention is not supported by either a specific and substantial credible asserted utility or a well-established utility." Appellants assert that this language not only appeared for the first time in the Examiner's Answer but that the examiner failed to set forth an explanation of lack of support for a well-established utility; and "as such, the rejection is not only a new ground of rejection, it is also an unexplained new ground of rejection". This argument has been given careful consideration but it is unpersuasive that the examiner addressed the lack of a well-established utility for the first time in the Answer. It is noted in the final rejection of February 01, 2006 that the action does refer at page 2 to there being "no apparent or disclosed specific and substantial credible utility," and one could read "apparent" as being the same as "well-established."

Appellants also submit the examiner asserted that "there is no evidence of record to show that 2.2412 polynucleotides are in fact differentially expressed in any tumors" which is in contrast to the examiner's position prior to the Examiner's Answer, which was that such evidence had to be in the disclosure as filed. This argument is not persuasive. The examiner, in stating that there is no evidence of record, is clearly making a statement, not modifying a requirement.

Appellants further submit that the Examiner's Answer introduced or reintroduced issues which were not clearly used as basis for the final rejection. Specifically, it is alleged the examiner resurrected additional issues in the Examiner's Answer because issues raised in the first Office action were not specifically set forth as basis for the final rejection but were repeated for "essentially for reasons of record" in the 35 U.S.C. 101 rejection. Appellants' points are well taken. It is noted that the prosecution history goes back 6 years, with the first FAOM having been issued on April 2, 2001. The sole statement of rationale for the 35 U.S.C. 101 rejection in the final rejection of February 01, 2006 is that the rejection is applied "essentially for reasons of record in appropriate sections of previous office actions of record." Given the long history of this case, it does appear difficult to ascertain what "sections" of previous Office actions are "appropriate" for the purpose of the final rejection, and how the reasons for rejection are intended to be qualified by the word "essentially." Since the grounds relied on in the final rejection of February 1, 2006 are ambiguous, it appears proper for the examiner to prepare a second Examiner's Answer so that the record is clear.

DECISION

The petition is **GRANTED**.

This application will be forwarded to the examiner for an action not inconsistent with this decision. Furthermore, the examiner will consider the Reply Brief filed November 9, 2006.

Should there be any questions about this decision please contact Ms. Marianne Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John LeGuyader

Director, Technology Center 1600